

REMARKS

Reconsideration of this Application is respectfully requested. Claims 1-26 are amended, without prejudice or disclaimer. Claims 1-26 are in this case.

Initially, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) on grounds that the drawings must show every feature of the invention specified in the claims. More specifically, the Examiner takes the position that the steps of the claimed method must either be shown or the feature(s) cancelled from the claim(s). He also indicates that such steps can readily be shown by way of a flow chart, but comments that no new matter should be entered. Corrected drawing sheets in compliance with 37 C.F.R. § 1.121(d) are required in reply to the Office Action to avoid abandonment of the Application.

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In response, Applicant has undertaken to provide two (2) additional sheets of formal drawings illustrating FIGS. 7 and 8, respectively, each with a flow chart indicating steps of the claimed method. We respectfully submit that such drawing sheets are added to this Application, without prejudice or disclaimer. No new matter has been added.

Withdrawal of the Examiner's objection is, therefore, respectfully requested.

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The Examiner then rejected claims 24-26 under 35 U.S.C. § 101 on grounds that the invention is directed to non-statutory subject matter. According to the Examiner, one of the subject matters Courts have found to be outside the four statutory categories of invention is abstract ideas. The Examiner refers Applicant, in this regard, to *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874), which purportedly held that "idea of itself is not

patentable, but a new device by which it may be made practically useful is”); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 U.S.P.Q. 199, 202 (1939). The Examiner explains that the instant claims fail to recite any physical structure or a sequence of physical steps that can be performed.

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Contrary to what is argued by the Examiner, we respectfully submit that the subject matter of claims 24-26 is directed to a method of playing an educational and therapeutic game which provides (i) articles, namely, a plurality of cards, each card having pictorial or textual data disposed thereon, and/or (ii) a device, i.e., a flexible wire, operable to be folded into shapes to represent a word, clause, phrase or a clue regarding the same, wherein at least one player chooses from the plurality of cards and then tries to shape and fold the flexible wire to represent the data, i.e., pictorial or textual, disposed on the card.

Applicant respectfully disputes the Examiner’s contention that his claimed method is merely an “idea” and, thus, non-statutory subject matter. Indeed, we submit, Applicant’s method, as claimed, relates to steps performed on a device and/or using articles and other statutory subject matter.

Based on the foregoing, withdrawal of the Examiner’s rejection under § 101 is appropriate.

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Next, the Examiner rejected claims 1-11, 13, 14, 22 and 23 under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Examiner takes the position that one cannot determine if claims 1-11 are directed to a method or an apparatus. The Examiner

indicates that, since the remaining claims recite a method, they are being treated, for purposes of this Office Action, as intended to being drawn to an apparatus.

Also, the Examiner explains that claims 13, 14, 22 and 23 recite rules and fails to set forth any further physical steps to be performed in the process of the game and is held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In this connection, the Examiner cites *Ex Parte Erlich*, 3 U.S.P.Q.2nd 1011 (Bd. Pat. App. & Inter. 1986).

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Pursuant to the Examiner's treatment of Applicant's claims 1-11 as "apparatus" claims, Applicant asserts that the present invention concerns a "game system" and, accordingly, has undertaken to amend claims 1-26, collectively, to better define the invention without limiting effect.

As for the Examiner's position that claims 13, 14, 22 and 23 merely recite rules and fail to recite any further physical steps to be performed, Applicant respectfully disagrees. In particular, it is Applicant's contention that use of body language, or prohibition of such use, is an optional step of the method of practicing the game system at hand.

Withdrawal of the Examiner's rejection under § 112 is requested.

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Thereafter, the Examiner rejected claims 1-10, 12-15 and 18-26 under 35 U.S.C. § 103(a) as being obvious and, therefore, unpatentable over What is Claymania in view of Wire Sculpture. Specifically, with regard to claims 1-3, 5-10, 12, 15 and 20-25, the Examiner takes the position that What is Claymania shows making a sculpture conforming to indicia on

cards out of clay within a given amount of time. He states that while the use of wire is not discussed, the prior art teaches that wire is a well-known media for making a sculpture. The Examiner explains that to have replaced the clay of What is Claymania with wire would have been an obvious matter of choosing one known media for that of another. He notes that Applicant has not shown his choice of media to be critical by solving any particular problem or producing any unexpected results.

With regard to claim 4, the Examiner asserts that providing individual color coded game paraphernalia to players is old and well-known. Similarly, says the Examiner, having cards categorized to different levels of difficulty, as purportedly set forth in claims 7, 19 and 25, is known in question and answer games.

As for claims 13, 14, 22 and 23, the Examiner argues that these claims reflect only rules of play that are analogous to functional limitations in an apparatus claim in that they fail to further limit the claim by reciting a positive physical step that can be performed. As such recitation, he says, fails to distinguish over the art of record, attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. § 112, second paragraph, as set forth above.

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Finally, the Examiner rejected claims 11, 16 and 17 under 35 U.S.C. § 103(a) as being obvious and, therefore, unpatentable over What is Claymania in view of Wire Sculpture in view of Cohen, U.S. Patent No. 5,120,066. More particularly, the Examiner indicates that in What is Claymania, prevailing players are recorded as being awarded a token that marks a space. He then looks to Cohen which, the Examiner says, teaches that it is known in question

and answer type games to have moves being awarded for correct answers to the cards and die and spinners are well-known equivalents with respect to random number generators. The Examiner concludes that, to have recorded the prevailing game events of What is Claymania with a spinner that awarded advancement of a players playing piece would have been obvious in order to record game events of a player.

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Applicant, however, respectfully disagrees with the Examiner's reading and application of the cited references.

First, we respectfully submit that, in What is Claymania, a board game is described in which a player is given a selected period of time, i.e., 45 seconds, to sculpt a mound of clay into an object while his/her teammates try to guess what the player is making. The player is allowed to "animate" the clay, but may not say a word. The first team to collect five colored tokens wins. In addition to clay, the game utilizes 300 word cards, 10 colored game tokens, 2 team markers, a square game board, an hourglass timer, and a die. According to its makers, Claymania develops creative expression, imagination, abstract thought, quick thinking and acting skills, language and vocabulary, as well as hand-eye coordination.

This is entirely different from Applicant's invention in which a player first decides what "word, phrase or clause" he/she wants to represent, and then shapes and/or folds a *flexible wire* into a shape that is either representative of the "word, phrase or clause" the player decided on, or of a "clue" which will aid his/her teammates in determining the word, phrase or clause the player has chosen. Specifically, the flexible wire may be folded into the actual shape of the word, or a shape representative of the word. The player may also use body

movement as a tool in communicating the identity of the word, phrase or clause or clue regarding the same. In addition to a flexible wire, the game provides a game board, a timer and a spinner. Points are awarded based upon the complexity of the word, phrase or the like. Unlike the stated objectives of What is Claymania, Applicant's invention is used for entertainment, educational and/or therapeutic purposes, namely, to improve fine motor skills, cognitive skills of children and/or the disabled.

Second, we respectfully submit that the Examiner's application of Wire Sculpture, which is an art form of creating works of art from wire, to Applicant's board game for entertainment, education and/or therapeutics, and his accompanying argument that such a combination would have been obvious to one having ordinary skill in the art is tantamount to a hindsight reconstruction. More specifically, we submit that the Examiner has concluded that Applicant's invention is obvious, not by applying one reference that necessarily suggests application of features in another, but rather by picking and choosing components and steps from separate and distinct inventions, albeit in unrelated fields, in order to arrive at Applicant's invention.

Moreover, even if it were obvious to combine What is Claymania with Wire Sculpture, we submit, the result would not show all of the features of Applicant's invention, as claimed. For example, the result would require colored game tokens which are not utilized by Applicant's game, and would be devoid of the "flexible wire" used by Applicant which is easily shaped and folded, e.g., bent, by a player's hands; unlike the hard or stiff wires that require welding and metal working tools as are used by artists to create a wire sculpture.

Similarly, Cohen, while relating to a board game, does not disclose or suggest Applicant's integration of a board game with wire shaping and folding, whether for entertainment, education and/or therapeutics.

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Given the foregoing differences, it is respectfully submitted that Applicant's invention is entirely different from that set forth by any of the references.

Indeed, we respectfully submit that none of the cited references, whether taken alone or in any combination, disclose or suggest Applicant's invention, as claimed. Withdrawal of the Examiner's rejections under § 103(a) is respectfully requested.

Applicant has made a good faith attempt to place this Application in condition for allowance. Favorable action is requested. If there is any further point requiring attention prior to allowance, the Examiner is asked to contact Applicant's counsel at (646) 265-1468.

Respectfully submitted,

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APPENDIX